

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed May 12, 2005. At the time of the Office Action, Claims 1-28 were pending in the Application. Applicant amends Claims 1, 12, 24, and 25 and cancels Claims 23 and 26 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 and 103 Rejections

The Examiner rejects Claims 1-4, 7-8, 11-13, 16, 19-21, 23, 27, and 29 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,047,051 issued to Ginzboorg, et al. (hereinafter "*Ginzboorg*"). The Examiner also rejects various claims under §103(a) using a number of references, including: U.S. Patent Number 5,956,391 issued to Melen (hereinafter "*Melen*"), U.S. Patent Number 5,970,477 issued to Roden (hereinafter "*Roden*"), etc. Note that the §102 and §103 rejections have been consolidated for purposes of clarity. This is due, in part, to the amendments, which made the §102 rejections moot. Therefore, the remaining §103 rejections are addressed below and respectfully traversed for the following reasons.

As an initial matter, Applicant is buoyed by the Examiner's recognition of the deficiencies of *Ginzboorg*, as *Ginzboorg* does not provide an appropriate basis for the previously posited §102 rejection. Applicant is optimistic that, in a similar fashion, the Examiner can be shown the disparate teachings of the cited §103 references when juxtaposed with the subject matter outlined by the pending claims. Applicant is confident that a mutually agreeable resolution can be reached with respect to the pending subject matter.

Applicant respectfully reminds the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. For example, Independent Claim 1, as amended, recites:

A method for providing a piece of content to a subscriber terminal from a content server, wherein the provision of the content from the content server to the subscriber terminal is controlled by a proxy, and said control of the content provision comprises the following steps:

- receiving in the proxy a content request for providing the content,
- determining by means of the proxy a billing address for the content,
- providing the content corresponding to the content request under the control of the proxy from the content server to the subscriber terminal, and
- *generating billing information related to the content, wherein generating billing information includes accessing a subscriber terminal profile, and wherein the subscriber terminal profile includes a prepaid amount provided by an end user of the subscriber terminal.*

The Examiner concedes that *Ginzboorg* fails to offer some of these limitations, as highlighted above, but incorrectly uses *Davis* to fill this void. Unfortunately, there is no citation provided by the Examiner with respect to *Davis*. Notwithstanding this oversight, *Davis* is still not relevant to the patentability of the pending claims because it fails to offer a pre-paid amount provided in a subscriber terminal for billing for content in a proxy configuration, as outlined by the pending claims. (Applicant has reviewed *Davis* in its entirety to confirm this contention.) Indeed, *Davis* provides no disclosure of a proxy architecture that offers any ability to generate billing information related to the content, which includes accessing a subscriber terminal profile that includes a prepaid amount provided by an end user of the subscriber terminal. Moreover, *Davis* appears to be so disparate in its teachings and its architecture that a strong argument could be made that it is simply not analogous art. In either case, *Davis* would not preclude the allowability of the

¹ See M.P.E.P. § 2142-43.

pending claims because of its inability to suggest, teach, or disclose any proxy system that includes a pre-paid amount being provided in a subscriber profile. Such a profile can be accessed in order to execute a number of billing functions: some of which are clearly circumscribed by the subject matter of the pending claims. Accordingly, Independent Claim 1 is patentable over the proposed *Ginzboorg-Davis* combination for at least these reasons.

In addition, Independent Claim 12 recites a similar (but not an identical) limitation and, thus, is allowable over this combination using a similar rationale. Additionally, using analogous reasoning, the corresponding dependent claims of these Independent Claims are also allowable over the references of record.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

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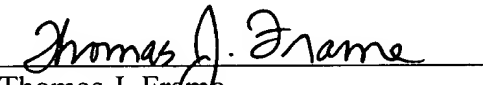
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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